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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,052	06/26/2001	Wolfgang Fritz	HOE605	1771

7590
Edward J. Timmer
Walnut Woods Center
5955 W. Main Street
Kalamazoo, MI 49009

11/14/2003

EXAMINER

COMPTON, ERIC B

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 11/14/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,052

Applicant(s)

FRITZ, WOLFGANG

N.K.

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-19,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-19,22 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 19 and 22-23 are rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (AAPA).

Claim 19 and 22-23, only require a gasket comprising a first and second layer or multiple layers having a contour line.

AAPA, as found on page 1 and page 12, fourth full paragraph to page 14, fourth full paragraph, discloses that gaskets of this type are known. See also Figure 2 (showing the second gasket layer projecting beyond the corner on the first gasket layer).

Note: the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-9, 11-19 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of DE 884936 ('936).

AAPA, as found on page 12, fourth full paragraph to page 14, fourth full paragraph, in reference to Figure 2, describes the conventional device (and process) for the production of gasket plate, having a follow-on combination tool (114) with several machining stations (122), a feeding device (106), and a tools for cutting the outer contour lines. Page 2, second paragraph, discloses, "Devices of this type are known from the state of the art."

However, the AAPA does not disclose that the facing outer contour lines of adjacent gasket layers are cut by a single tool using the same cutting edge.

An oral translation of DE '936, reveals that the invention discloses a device (and process) for the production of fittings (a) for furniture. A sheet of metal (b) is feed to a combination tool (see Fig 1), having multiple punches (f,g,h,i). In the final step, a section is cut from the sheet by the punch (i), which cuts the contour lines of adjacent sections using the same cutting edge. It is inherent that a feeding device is provided that moves

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the section (a) to become fittings through the combination tool by a feed distance equal to the width of one section.

Regarding claims 1, 5, 6, 8, and 9, 13, 14, 16, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have formed the gasket layer of AAPA, by a device (and process) wherein the facing outer contour lines of adjacent gasket layers are cut by a single tool using a the same cutting edge, in light of the teachings of DE '936, in order to reduce waste material between adjacent layers in the prior art.

Regarding claims 4 and 11-12, both AAPA and DE '936 disclose a feed cutting station (138, and f, respectively) arranged in front station for cutting the outer contour lines, and transverse to the cutting station.

Regarding claims 7 and 15, the angle between the edges of the cutting tool (f) of DE '936 is not disclosed. The cutting angle affects the overall cutting of the contour lines. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the cutting angle 90 degrees, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 17, AAPA discloses gaskets having multiple layers.

Regarding claim 18, AAPA discloses gaskets having multiple layers. However, they do not disclose that the outer contour lines of adjacent layers essentially point symmetric to one another.

Regarding claims 19, and 22-23, the product claimed is inherently produced by the process of AAPA/DE '936. Furthermore, the method of forming the device is not germane to the issue of patentability of the device itself. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these limitations have not been given patentable weight.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/DE '936 in view of either US Patent 4,862,574 to Seidy, US Patent 3,998,300 to Sullivan, or US Patent 3,822,461 to Malmstrom.

AAPA/DE '936 discloses the invention cited above, specifically AAPA discloses gaskets having multiple layers. However, they do not disclose that the outer contour lines of adjacent layers essentially point symmetric to one another.

Siedy, Sullivan, and Malmstrom, all teach fabricating products from sheet material and subsequently cutting along an outer contour line of the adjacent product. Furthermore, the outer contour lines of the adjacent products have been designed to essentially point symmetric to one another. Such a design allows for products having non-linear contour lines to be packed densely without waste material between adjacent products.

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Regarding claim 18, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have designed the outer contour lines of adjacent layers to point symmetric to one another, in light of the teachings of either Siedy, Sullivan, or Malmstrom, in order to provide a greater packing density, without waste between adjacent products.

Response to Arguments

6. Applicant's arguments filed September 29, 2003, have been fully considered but they are not persuasive.

In response to applicant's argument that the prior art of DE '936, U.S. '574, U.S. '300, and U.S. '461 are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant points out that a purpose of the invention, "in the case of the inventive device the facing outer contour lines of tow adjacent gasket layers abut directly on one another and so no waste material results between the adjacent layers and the starting material is utilized better." Specification, page 3, third paragraph. While, the prior art cited above, may not necessarily teach gasket layers, they do teach and suggest process lines for producing articles in which contour lines of adjacent articles abut directly on one another, in order to save material (i.e., no waste between articles). See '300 Cols. 1-2, lines 65-5; '574 Col 2., lines 34-35; '461 Col. 3,

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line 14. Thus the prior art clearly meets the second prong of the *Oetiker* test for being reasonably pertinent to the particular problem, which Applicant faced and thus may be properly relied upon as a basis for rejecting the claims.

Secondly, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Specifically, Applicant contends that DE '936 does not teach or suggest the cutting tool dipping into the cutting area cut by the punching tools in the preceding punching stations.

AAPA, as embodied in Figure 2, shows at least one free-cutting tool (138) having a corner free shape for free-cutting at least one area out of the starting material, essentially the same design as Applicant's claimed cutting tool. Cf. Figure 3 (129'); Attachment B. With regards to the prior art of Figure 2, Applicant discloses, "The lateral separating areas 138 punched out of the sheet metal by the separating punched of the separating station 136 and **the central separating area 140 overlap the free-cutting areas 129 cut out by the free-cutting punches of the free-cutting station 128 such that the outer contour lines cut by the free-cutting punches and by the separating punches adjoin one another smoothly and without any formation of corners.**" *Id.*, pages 13-14. (emphasis added). Thus, AAPA clearly discloses that the tools for cutting the contour lines of the gasket dip into the cutting areas cut by the free-cutting tools.

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The only main difference in Applicant's invention and AAPA is that the outer contours lines of adjacent gaskets do not coincide. *Compare* Figure 2 with Figure 3. "[T]he facing outer contour lines of two adjacent gasket layers must be cut by two different cutting edges." Specification, page 2, second paragraph. Therefore, it was the object of Applicant's invention to provide a device having "the tool for cutting the outer contour lines is designed such that the outer contour lines of the two adjacent gasket layers are cut with the same cutting edge ..." *Id.* fourth paragraph.

In DE '936, there are a number of cutting tools (f,g,h,i). The cutting tools (f,g) corresponds generally to the free-cutting tools (138) of AAPA and free-cut the edge of the parts (a). The other cutting tools (h) punch holes necessary to produce the particular part (a), but do not correspond to Applicant's invention in any material way. In the last step, the final cutting tools (i) cut along a coinciding (or common) contour line between adjacent parts (a). Cutting tool (i) is therefore satisfies the limitation that the "cutting edge of the tool for cutting outer contour lines of the station for cutting outer contour lines," as required by the claims. *Compare* with Specification, page 3, first paragraph (disclosing "only a single cutting edge for each pair of adjacent gaskets"). Furthermore, it is apparent in Fig. 1 of DE '936, that when the cutting tool (i) cuts the contour lines between the adjacent parts (a) it also dips into the area that had been previously cut with the cutting tool (g). See Attachment A. Therefore, the limitation of "the cutting edge of the tool for cutting contour lines of the station for cutting outer contour lines dipping into said free-cutting area during the cutting procedure," as required by the claims is taught by both AAPA and DE '938.

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Therefore, Examiner maintains the rejections of the claims above.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (703) 305-0240. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter B. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Eric Compton
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AU 3726



PETER VO
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November 4, 2003